

REMARKS

Claim 10 is canceled without prejudice, and claims 8, 9 and 11 to 16 are therefore pending in the present application.

In view of the following, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is therefore respectfully requested.

With respect to paragraph eight (8) of the Final Office Action, Applicants thank the Examiner for indicating that claims 10, 15 and 16 contain allowable subject matter. While the objections may not be agreed with, to facilitate matters, claim 8 has been rewritten to include the features of allowable claim 10, which has been canceled without prejudice. Accordingly, claim 8 is allowable, as are its dependent claims 9 and 11 to 14. Claim 15 has also been rewritten to include the features of original claim 8, so that claim 15 is allowable, as is its dependent claim 16. It is therefore respectfully requested that the objections be withdrawn.

With respect to paragraph eight (8) of the Final Office Action, claims 8 was rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 6,097,314 (“Desens”).

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and

the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

While the rejections may not be agreed with, to facilitate matters, claim 8 has been rewritten to include the features of allowable claim 10, which has been canceled without prejudice. Accordingly, claim 8 is allowable, as are its dependent claims 9 and 11 to 14. Claim 15 has also been rewritten to include the features of original claim 8, so that claim 15 is allowable, as is its dependent claim 16. It is therefore respectfully requested that the rejection be withdrawn.

Claims 9 and 14 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Desens reference further in view of U.S. Patent No. 6,265,968 (“Betzitza”).

Claims 10, 11 and 13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the Desens reference further in view of U.S. Patent Application Publication No. 2002/0161520 (“Dutta”).

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

While the rejections may not be agreed with, to facilitate matters, claim 8 has been rewritten to include the features of allowable claim 10, which has been canceled without prejudice. Accordingly, claim 8 is allowable, as are its dependent claims 9 and 11 to 14. Claim 15 has also been rewritten to include the features of original claim 8, so that claim 15 is allowable, as is its dependent claim 16. It is therefore respectfully requested that the rejections be withdrawn.

Accordingly, claims 8, 9 and 11 to 16 are allowable.

CONCLUSION

In view of the foregoing, it is respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections and objections be withdrawn. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully Submitted,
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